

Attorney Docket No: 28110/35918

3-10-01

Applicant: Drmanac, et al.

Application Serial No. 09/479,608

Filed: January 6, 2000

For: Enhanced Sequencing by Hybridization Using Pools of Probes

Group Art Unit: 1655

Examiner: F. Lu, Ph.D.

) I hereby certify that this paper is being
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Joseph A. Williams, Jr., Reg. No. 88/659

APPLICANTS' RESPONSE TO A RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Sir:

In response to a restriction requirement mailed October 25, 2000, to which a response is due February 26, 2001 with a one month extension of time, Applicants herein elect claims 1 to 35, designated as Group I by the Examiner, for continued prosecution in the above application.

The Examiner also asserted in the communication including the restriction requirement that the application fails to comply with the rules for sequence disclosure. The Applicants respectfully disagree.

The subject matter of the claims relates to improved methods for carrying out sequencing by hybridization and tools (i.e., pools of probes) for carrying out these methods. Throughout the specification, sequences are in fact included, but none of the disclosed sequences are significant to patentability of the methods or the pools of probes. Instead, these *hypothetical* sequences are provided only to exemplify the methods and the pools and any relationship to a known polynucleotide sequence is coincidental.

For example, at page 49, lines 15-26, the nine “hypothetical 10mers” are used to illustrate how the sequence of an 18mer can be deduced from the nine

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overlapping 10mers and, beginning at page 50, line 30, to page 52, line 33, a "theoretical" nucleic acid sequence is disclosed and methods for extending sequence analysis in 5' and 3' directions from a single positive probe are taught. In Appendices 2-4, the methods are exemplified with an "experimental target sequence" and possible deduced sequences are described based on the results from the hybridization data.

The MPEP at section 2421.01, describing "Applications Affected" by the sequence rules states,

The sequence rules require the use of standard symbols and a standard format for sequence data in *most sequence-type patent applications*.

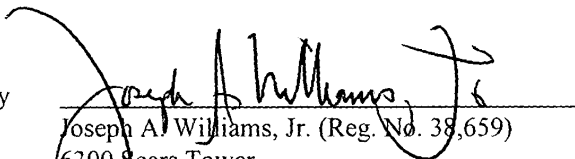
From this statement, it is clear that *not all* applications that include sequences must also include a formal sequence listing. Moreover, the present application is not a *sequence-type* application, but is a materials and methods type application for determining sequence information. In fact, the present application could have been drafted completely devoid of any sequences, but the Applicant chose instead to provide examples for the purpose of demonstrating how the claimed method could be employed.

The Applicant respectfully submits that a formal sequence listing in compliance with the rules for sequence data is unnecessary in the present application and that the requirement set out at page 3 of the October 25, 2000 communication may properly be withdrawn.

Respectfully submitted,

MARSHALL, O'TOOLE, GERSTEIN,
MURRAY & BORUN

By


Joseph A. Williams, Jr. (Reg. No. 38,659)
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
(312) 474-6300

February 26, 2001